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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,043	04/27/2001	Richard Hans Harvey	063170.6290	2690
5073	7590	03/09/2009		
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER CORRIELUS, JEAN M	
			ART UNIT 2162	PAPER NUMBER
			NOTIFICATION DATE 03/09/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

09/844,043

**Applicant(s)**

HARVEY, RICHARD HANS

**Examiner**

Jean M. Corielus

**Art Unit**

2162

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-9, 12-17, 20-22, 24-28 and 31-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-9, 12-17, 20-22, 24-28 and 31-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/3508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

1. This office action is in response to the amendment filed on January 29, 2009, in which claims 1, 4-9, 12-17, 20-22, 24-28 and 31-36 are presented for further examination.

***Response to Arguments***

2. Applicant's arguments filed on January 29, 2009 have been fully considered but they are not persuasive. (See examiner remark).

***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Applicant fails to provide antecedent basis for the claim terminology "one or more memory modules and one or more processing unit".

***Information Disclosure Statement***

4. The information disclosure statement (IDS) filed on November 25, 2008, December 24, 2008, and February 10, 2209 complies with the provisions of M.P.E.P 609. It has been placed in the application file. The information referred to therein has been considered as to the merits.

***Remark***

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 4-9, 12-17, 20-22, 24-28 and 31-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Although the claims 1, 3-8, 17, 20-21 and 24-27 recite a “method,” it is unclear whether the method is necessarily tied to any computer hardware, thereby defining a statutory process. *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (en banc). Applicant is reminded that a statutory process must (1) be “tied” to another statutory class (such as a machine) or (2) “transform” underlying subject matter (such as an article or materials) to a different state or thing. *Id.* Since the instantly claimed method does not appear to satisfy either requirement, the method is not a “process” within the meaning of § 101.

Claims 9 and 12-16 recite a directory services arrangement comprising: means for expanding, a condition test means and means for applying. The 112 sixth paragraph has been invoked. However, it appears that the specification does not provide a physical hardware to process the means as claimed. Therefore, the claims fail to satisfy the requirements within the meaning of 101.

Claim 28 is directed to a directory services arrangement that comprises one or more memory modules and one or more processing units. Applicant has failed to provide antecedent basis for the claim terminology “one or more memory modules and one or more processing units. A physical hardware is not an element of the claimed system. After further review the

specification it is evident that system would suggest to one of ordinary skill that all may be reasonable implement as software routines. Therefore, the claims are rejected as a system of software per se, for failing to fall within a statutory category of invention Applicant is advised to show how the means-plus-function is read into the specification

Claims 1, 9, 17, 28 and 36 recite "if a determination is made that the filter item comprises a NOT connective and a type only filter item, applying a logical methodology to evaluate the filter item, the logical methodology comprising expanding an expression of the filter item so that the filter item does not comprise the NOT connective". It appears that there is no end result under the condition, when the determination is made that the filter item comprises a NOT connective and a type filter item. Applicant should duly note that the specification requests that both conditions be satisfied in order to process the database service query. Therefore, the claims fail to fall within a statutory category.

Applicant should duly the claimed "if the filter item with a NOT connective is a type and value filter item then the present application pushes the NOT connective, into the filter item which avoids a NOT in the outer SQL." Such claimed is clearly in contradiction with the specification because "The logical methodology may be the a subtraction method expressed in expression below or any other suitable methodology capable of expanding an expression so that the filter item does not contain NOT connectives", thus neither of the above claimed limitations can be used to introduce subject-matter into the claims without providing sound and technically well reasoned basis why, and which one of them, is technically incorrect, and further requesting to correct the claimed limitations. From a technical point of view, the person skilled in the art, reading the description in order to implement the invention, does not know whether the NOT

connective may be pushed into the filter item to avoid a NOT in the outer SQL, or has to be eliminated as such from the whole SQL statement. Clarification is strongly advised. However, the statement that the underlying problem is solved by identifying filter items comprising a NOT connective and processing them to eliminate the NOT connectives before generating an appropriate SQL statement immediately leads to the essential fact that the filter items in general and especially the NOT connectives of type-only filter items are still not formulated in SQL at the end of the method claimed. The result of the last step of claim 1 is thus highly unclear in that it is not clear, to which expression the SQL code representing the processed filter item is to be added and what is the outcome of this addition. According to the presently formulated claim 1, the outcome would be a mixture of the original directory service query, comprising any filter items without a NOT connector and type only filter items with NOT connector, and SQL code representing the processed type-and-value filter items which originally comprised a NOT connector. The technical effect of such a mixture, especially with regard to any further processing, is not derivable from the claims or from the application as a whole and leads to a highly unclear definition of the invention by the claims, as the underlying problem (how to optimize certain directory service queries) is obviously not yet solved. It is thus especially to be noted that the invention as claimed does not comprise the feature of generating a SQL query from a LDAP query. The result of the method as claimed is an undefined mixture of SQL and LDAP query. It is, however, absolutely necessary to add claims 4 - 6 into independent claim 1; claims 12-14 into independent claim 9; claims 24-25 into independent claim 17; and claims 31-33 into independent claims 28 and 36 in order to define an actual solution of the optimization

problem, it is necessary to arrive, within the claims, at a final SQL statement representing the complete transformation of the directory search query into SQL, i.e. including the SQL.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jean M Corrielus/  
Primary Examiner, Art Unit 2162

March 5, 2009